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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/800,668	03/16/2004	Naoko Tsuji	250198US0DIV	3020
22850	7590 03/29/200	i e	EXAM	INER
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET			WITZ, JEAN C	
ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER
	,		1651	

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)		
	10/800,668	TSUJI ET AL.		
Office Action Summary	Examiner	Art Unit		
	Jean C. Witz	1651		
The MAILING DATE of this communicated Period for Reply	ation appears on the cover sheet v	with the correspondence address		
A SHORTENED STATUTORY PERIOD FOI THE MAILING DATE OF THIS COMMUNIC. Editorsions of time may be available under the provisions of the provision of the provisio	ATION. 37 CFR 1.136(a). In no event, however, may a location. days, a reply within the statutory minimum of the tory period will apply and will expire SIX (6) MC, lby statute, cause the application to become.	a reply be timely filed irty (30) days will be considered timely. NTHS from the mailing date of this communication. ABANDONED (35 U.S.C. § 133).		
Status		•		
1) Responsive to communication(s) filed	on			
2a) This action is FINAL. 2b) This action is non-final.			
Since this application is in condition for allowance except for formal matters, prosecution as to the merits is				
closed in accordance with the practice	under Ex parte Quayle, 1935 C.	D. 11, 453 O.G. 213.		
Disposition of Claims				
4) Claim(s) 6-12 is/are pending in the ap	plication.			
4a) Of the above claim(s) is/are				
5) Claim(s) is/are allowed.	,			
6)⊠ Claim(s) 6-12 is/are rejected.				
7) Claim(s) is/are objected to.				
8) Claim(s) are subject to restriction	on and/or election requirement.			
Application Papers				
9) The specification is objected to by the	Examiner.			
10)⊠ The drawing(s) filed on 16 March 2004	! is/are: a)⊠ accepted or b)□ o	bjected to by the Examiner.		
Applicant may not request that any objecti	on to the drawing(s) be held in abey	ance. See 37 CFR 1.85(a).		
Replacement drawing sheet(s) including the	ne correction is required if the drawin	g(s) is objected to. See 37 CFR 1.121(d).		
11)☐ The oath or declaration is objected to b	by the Examiner. Note the attach	ed Office Action or form PTO-152.		
Priority under 35 U.S.C. § 119				
12)⊠ Acknowledgment is made of a claim fo	r foreign priority under 35 U.S.C.	§ 119(a)-(d) or (f).		
a)⊠ All b)□ Some * c)□ None of:				
1. Certified copies of the priority de	ocuments have been received.			
Certified copies of the priority de	ocuments have been received in	Application No. 09/220,691.		
Copies of the certified copies of		en received in this National Stage		
application from the Internation				
* See the attached detailed Office action	for a list of the certified copies no	ot received:		
Attachment(s)				
Notice of References Cited (PTO-892)	4) Interview	v Summary (PTO-413)		
 Notice of Draftsperson's Patent Drawing Review (PT) 	0-948) Paper N	o(s)/Mail Date		
Information Disclosure Statement(s) (PTO-1449 or Pi Paper No(s)/Mail Date	TO/SB/08) 5) Notice o	f Informal Patent Application (PTO-152)		

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DETAILED ACTION

Priority

Applicant has not complied with one or more conditions for receiving the benefit
of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a nonprovisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Applicants have identified this application as a division of Application No. 09/220.691, filed December 28, 1998. A divisional application is defined as a later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application. The divisional application should set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application. A review of the parent application provides no indication that a restriction requirement was made during the prosecution of the parent application. Therefore, it appears that the instant application is a continuation of the parent application. Appropriate correction is requested.

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Claim Rejections - 35 USC § 102

 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- Claims 6-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by
 U.S. Patent 5.095.007 to Ahluwalia.

The reference discloses compounds effective to inhibit hair growth. Specifically identified are phosphonic acid compounds and derivatives thereof. See col. 1, lines 43-50. Absent objective evidence to the contrary, the characteristic of inhibition of the neutral endopeptidase is deemed an inherent characteristic of the disclosed compounds since they share the structural similarity claimed and have the same therapeutic activity of inhibition of hair growth. Once a reference teaching a product appearing to be substantially identical to the claimed invention and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the Applicant to show that the claimed invention is novel over the cited prior art.

 Claims 6 and 8-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 5.962,466 to Styczynski et al.

The reference discloses compounds effective to inhibit hair growth. Specifically identified are phosphonic acid compounds and derivatives thereof. See claim 8.

Absent objective evidence to the contrary, the characteristic of inhibition of the neutral endopeptidase is deemed an inherent characteristic of the disclosed compounds since

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they share the structural similarity claimed and have the same therapeutic activity of inhibition of hair growth. Once a reference teaching a product appearing to be substantially identical to the claimed invention and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the Applicant to show that the claimed invention is novel over the cited prior art.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 6-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,747,017. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims discloses the use of the same compounds for the same ultimate purpose. When the specification is consulted to determine the definition and scope of the term "neutral endopeptidase inhibitor", the term is deemed to encompass the same phosphonic acid compounds and derivatives

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and salts thereof as those claimed phosphonic acid compounds, derivatives and salts thereof. Therefore, the cited claims inherently performs the claimed method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean C. Witz whose telephone number is (571) 272-0927. The examiner can normally be reached on 6:30 a.m. to 4:00 p.m. M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jean Č. Witz Primary Examiner